

engaging layer and at least one non-skin engaging layer, said skin engaging member being adapted to change color by erosion of the skin engaging layer during shaving to indicate the end of its effective life.

93 Sub F17
32. (Amended) A skin engaging member in the form of a narrow elongated strip of dimensions suitable for placement on a razor cartridge, said skin engaging member comprising two disparately colored, solid polymeric layers, said layers comprising an erodible skin engaging layer of a first color and a non-skin engaging layer of a different color, said skin engaging layer comprising a blend of polyethylene oxide and a water insoluble polymer, said polyethylene oxide being water-leachable from said skin-engaging layer, and said non-skin engaging layer comprising a water insoluble polymer, wherein said skin engaging layer erodes during shaving to visually expose said non-skin engaging layer.

Attached as Appendix A are the amended claims marked to show the changes that have been made.

Reply to Examiner's Office Action

In the Examiner's Office Action mailed October 23, 2000, the Examiner allowed claims 20-26, 38 and 39. The Examiner indicated that claim 41/39 is allowable over the prior art of record. The Examiner also indicated that claims 32-37 appear that they would be allowable if

rewritten or amended to address the rejections made under 35 U.S.C. § 112.

Response to § 112 rejections

While applicant strongly disagrees with the asserted rejections, he has amended claims 27, 30, 31 and 32 in an effort to reduce the number of issues in this case. In claims 27 and 32, the criticized "adapted to" language has been removed and replaced with a specified dimension ("narrow elongated strip of dimensions suitable for placement on a razor cartridge"). In claims 30 and 31, the criticized "adapted to" clause has been further clarified by specifying how the color change occurs. (Applicant notes that claim 31 was not rejected on § 112 grounds.) It is believed that these amendments add sufficient precision to obviate this ground of rejection.*

Response to § 102 and § 103 rejections

Wolf U.S. Patent 1,292,982

Claims 27-30 stand rejected under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103(a) as anticipated by Wolf

* Applicant respectfully submits that although the amendment of claims 27 and 32 was made to overcome a rejection under 35 U.S.C. § 112, which is a statutory requirement for patentability, the amendment did not change the scope of the claims. Furthermore, the Examiner understood the scope of the claims sufficiently to determine their patentability in regard to the prior art. Therefore, applicant believes that the amendment is not a "substantial amendment related to patentability" within the meaning of Festo Corp. v. Shokatsu Kinzokukogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000), but instead relates merely to a matter of form.

(U.S. Patent 1,292,982). Applicant respectfully traverses this rejection.

Wolf essentially discloses soap contained within a sack. Even though one of Wolf's embodiments is directed to providing shaving soap to a user's face, it is clearly intended for application prior to shaving. Shaving soap, similarly to modern shaving creams and gels, was applied prior to shaving as a means of hydrating the hairs being shaved. It is well known in the art that hydrated hairs are more comfortable to shave and offer less resistance than dry hairs (Stoner et al. U.S. Patent 5,500,210, col. 1, lines 15-24). The present invention serves an entirely different purpose. The water soluble polymer shaving aid of the present invention serves as a lubricant, reducing the friction between the razor cartridge and the area being shaved. The lower frictional drag results in a much more comfortable shave (Booth U.S. Patent 4,170,821, col. 1, lines 13-15, col. 4, lines 61-66). Having both pre-shaving-applied soap, such as Wolf, and during-shaving-applied shaving aid, such as the present invention, leads to an improved shaving experience. Replacing applicant's intra-shave shaving aid applicator with Wolf's pre-shave shaving soap applicator would not be desirable.

In addition, claim 27 recites that the skin engaging member is "in the form of a narrow elongated strip of dimensions suitable for attachment to a razor cartridge."

Wolf specifically suggests a hand held soap-filled sack made of horsehair and rubber, said sack being large enough for printing the manufacturer's name and hanging when not in use (col. 4, lines 86-114). There would have been no motivation to miniaturize the Wolf sack for attachment to a razor cartridge, as this would have destroyed the intended use and function of the Wolf sack, to generate lather for preshave application.

Therefore, Wolf does not anticipate claim 27, and it neither anticipates or renders obvious claims 28-30.

Rogers U.S. Patent 5,113,585

Claims 27, 28, 40 and 41/40 stand rejected under 35 U.S.C. § 102(b) as anticipated by Rogers (U.S. Patent 5,113,585).

As the Examiner is aware, Tseng v. Doroodian-Shoja, Interference No. 104,482, involving Tseng's Application No. 08/461,318, is currently pending. In the Interference, Doroodian-Shoja's expert, Dr. Anthony Booth, has argued that wear of the "shaving aid composite" shown as element 42 in Figure 1 of the Rogers '585 patent would wear with use but "[a] shaver would not be able to see that" (see Appendix B, Booth 8/17/2000 Tr. 214, lines 3-12). The strip shown as element 42 in Figure 1 of Rogers '585 is functionally identical to element 64 in Figure 3 (col. 3, lines 21-26). If, as Dr. Booth contends, shavers are unable to see wear on the Rogers '585 strip, then it is not an

indicator strip as claimed in the present invention.

Although Tseng disputes that contention, should the Board of Patent Appeals and Interferences agree with Doroodian-Shoja, then it would be the position of the Patent and Trademark Office that Rogers '585 does not anticipate or render obvious claims 27, 28, 40 and 41.

Claims 29-31 and 41/31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rogers '585 in view of Creasy et al. '287 (U.S. Patent 4,875,287). There is no motivation to combine Rogers '585 with Creasy. Combining the strips would destroy the functionality of both strips. Without motivation to combine the patents any proposed combination is impermissible hindsight reconstruction.

Rogers '585 operates completely differently from Creasy. Creasy reduced friction between the razor cartridge and the shaved surface by means of a hydrogel film. The hydrogel film of Creasy is a polymer that absorbs water in order to provide a smooth, low friction surface. Rogers '585 uses a solid polymeric strip based on a polyethylene oxide/polystyrene blend water soluble polymer that leaches and abrades out of an insoluble matrix. There is no motivation in either patent to combine it with the other, competing, technology. Further, combining the technologies would destroy their mode of operation.

In Re Fritch states: "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'" 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citation omitted); see also, Texas Instruments Inc. v. U.S. Int'l Trade Comm'n, 988 F.2d 1165, 1178, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993) ("Absent ... [a] suggestion to combine the references, respondents can do no more than piece the invention together using the patented invention as a template. Such hindsight reasoning is impermissible."); In re Gorman, 933 F.3d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) ("As in all determinations under 35 U.S.C. section 103, the decisionmaker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps."). As explained above, the prior art patents cited by the Examiner contain no motivation for combination and have mutually exclusive methods of operation. Given that, the Examiner's suggestion that the present invention is an obvious combination of two

competing prior art technologies is impermissible hindsight reconstruction.

Therefore claims 29-31 and 41/31 are patentable over Rogers '585 in view of Creasy.

Potential Interferences

The Examiner is respectfully reminded that claims 27-31 and 38-41 are substantially similar to claims originally presented in Wexler et al. PCT published application WO 96/04112. Applicant respectfully reiterates his request that the Examiner determine whether any Wexler et al. U.S. application has an allowable claim that would be appropriate for declaration of an interference with this application.

As the Examiner is aware, on November 14, 2000, applicant submitted a Request For Suspension Of Prosecution Or, In The Alternative, Request For Declaration Of An Interference Pursuant To 37 C.F.R. § 1.604 in Doroodian-Shoja Application No. 09/024,371. Applicant submits herewith, at Appendix C, a copy of this paper for consideration by the Examiner in connection with the instant application, particularly applicant's request for declaration of an interference between this application and Doroodian's Application No. 09/024,371.

Conclusion



Applicant appreciates the Examiner's allowance of claims 20-26, 38 and 39.

With the above reply, it is submitted that claims 20-41 are now in condition for allowance.

A favorable action is respectfully requested.

Applicant Intends To Submit
A Petition For A Stay Of Prosecution

Applicant intends shortly to petition for a stay of prosecution pursuant to 37 C.F.R. § 1.103(a), based on the pending Tseng v. Doroodian-Shoja, Interference No. 104,482, which involves Tseng Application No. 08/461,318, the parent application to this application.

Should the Examiner take up this application prior to the time applicant has submitted his petition, applicant respectfully requests that the Examiner contact the undersigned at (212) 596-9130.

Respectfully submitted,

John E. Nathan
Registration No. 26,778
Richard A. Inz
Registration No. 31,375
Attorneys for Applicant
c/o FISH & NEAVE
1251 Avenue of the Americas
New York, New York 10020
Tel.: (212) 596-9000

APPENDIX A

AMENDED CLAIMS MARKED TO SHOW
CHANGES THAT HAVE BEEN MADE



27.(Thrice Amended) A skin engaging member [sized and adapted for attachment to] in the form of a narrow elongated strip of dimensions suitable for placement on a razor cartridge, said skin engaging member comprising a water insoluble polymer, an amount of a water soluble shaving aid and means in said skin engaging member for gradually indicating a change in said amount of said shaving aid.

30.(Amended) The skin engaging member of claim 29 which is adapted to change color by erosion of the skin-engaging layer during shaving to indicate the end of its effective life.

31.(Thrice Amended) A razor cartridge comprising a blade and a skin engaging member affixed adjacent said blade, said skin engaging member comprising a water insoluble polymer, an amount of a water soluble shaving aid and means in said skin engaging member for gradually indicating a change in said amount of said shaving aid, said means for indicating comprising at least one coloring agent, said skin engaging member comprising at least one skin engaging layer and at least one non-skin engaging layer, said skin engaging member being adapted to change color by

erosion of the skin engaging layer during shaving to indicate the end of its effective life.

32.(Amended) A skin engaging member [for use] in the form of a narrow elongated strip of dimensions suitable for placement on a razor cartridge, said skin engaging member comprising two disparately colored, solid polymeric layers, said layers comprising an erodible skin engaging layer of a first color and a non-skin engaging layer of a different color, said skin engaging layer comprising a blend of polyethylene oxide and a water insoluble polymer, said polyethylene oxide being water-leachable from said skin-engaging layer, and said non-skin engaging layer comprising a water insoluble polymer, wherein said skin engaging layer [is adapted to be immovably affixed to said razor cartridge and to] erodes during [use] shaving to visually expose said non-skin engaging layer.